

Application No.: 10/568,488
Filing Date: March 25, 2008

REMARKS

Claims 1, 8-10, 14-20, 25, 29, 31, 34, 41-43, 47-53, and 58 were previously pending. Applicants have canceled claims 1, 8-10, 14-20, 25, 29, 31, 41 and 47 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Applicants have amended claim 34 to recite a modified oligonucleotide consisting of 13 to 30 linked nucleosides, wherein the modified oligonucleotide comprises at least one modified sugar moiety or modified nucleobase, and wherein the modified oligonucleotide specifically hybridizes to SEQ ID NO:1. Support for this amendment can be found throughout the specification as filed, for example, at page 9, lines 16-19; page 12, lines 4-11. Applicants have amended claim 51 to recite “or a 4’- (CH₂)_n-O-2’ bridge, wherein n is 1 or 2.” Support for this amendment can be found throughout the specification as filed, for example, at page 21, lines 15-25. Claim 58 is amended to recite a pharmaceutically acceptable salt. Support for this amendment can be found throughout the specification as filed, for example, at page 48, lines 30-32.

Applicants have added new claims 68-82. Support for these claims can be found throughout the specification as filed, for example, at page 36, line 23 through page 37, line 31; page 76, lines 3-15; Examples 13, 16, 17; and original claims 1-33.

Applicants submit that no new matter is added and request entry of the amendments to the claims. Claims 34, 42-43, 48-53, 58 and 68-83 are be pending.

35 U.S.C. § 102(e)

Claims 34 and 43 are rejected under 35 U.S.C. § 102(e) as anticipated by US 5,994,076. The Office asserts that the claim limitation about 19 to about 23 nucleobases in length encompasses an oligonucleotide 26 nucleobases in length. Without acquiescing to the rejection, and solely in the interest of advancing prosecution, Applicants have amended claim 34 to recite “wherein said modified oligonucleotide comprises at least one modified sugar moiety or at least one modified nucleobase.” Applicants submit that the 5,994,076 patent does not expressly or

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inherently disclose this claim limitation. Applicants therefore request that the rejection of claims 34 and 43 under 35 U.S.C. § 102(e) over US 5,994,076 be withdrawn.

35 U.S.C. § 103(a)

Claims 34, 41, 43, and 47-49 are rejected under 35 U.S.C. § 103(a) as unpatentable over US 5,994,076 in view of Skerra A. (Nucleic Acids Res. 1992, 20:3551-3554).

Applicants note that claims 50 and 52, which recite at least one modified sugar moiety and at least one modified nucleobase, respectively, are objected to as being dependent on an allowable base claim, but would be allowable if rewritten in independent form. Without acquiescing to the rejection, and solely in the interest of advancing prosecution, Applicants have amended claim 34 to recite “wherein said modified oligonucleotide comprises at least one modified sugar moiety or at least one modified nucleobase.” Applicants submit that in view of the amendment to claim 34, claim 34 and the claims which depend therefrom are allowable. Applicants request reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103(a).

Request for Rejoinder

Applicants have added new claims 71-82, which recite a method of decreasing airway hyperresponsiveness or airway inflammation by administering the compound of claim 34. Claims 34 and 71-82 are related as product and process claims. Applicants request rejoinder of the withdrawn method claims 71-82 as they require all the limitations of allowable composition claim 34.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure,

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including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Patents and Applications

Applicants wish to draw the Examiner's attention to the following patents/applications. Applicants encourage the Examiner to review and monitor the file history of these patents/applications, including all Office Actions, throughout the pendency of the instant application.

Patent / Serial Number	Title	Issued / Filed
6,140,124	ANTISENSE MODULATION OF P38 MITOGEN ACTIVATED PROTEIN KINASE EXPRESSION	10-31-2000
6,448,079	ANTISENSE MODULATION OF P38 MITOGEN ACTIVATED PROTEIN KINASE EXPRESSION	9-10-2002
09/958,087	ANTISENSE MODULATION OF P38 MITOGEN ACTIVATED PROTEIN KINASE EXPRESSION	2-12-2002
10/238,442	ANTISENSE MODULATION OF P38 MITOGEN ACTIVATED PROTEIN KINASE EXPRESSION	9-9-2002
10/641,455	ANTISENSE MODULATION OF P38 MITOGEN ACTIVATED PROTEIN KINASE EXPRESSION	8-15-2003

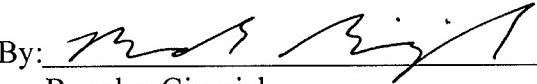
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Applicants submit that the present application is in condition for allowance and respectfully requests an action to that effect. If any issues remain, the Examiner is invited to contact Applicants' counsel at the number provided below in order to resolve such issues promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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